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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional): A-6687 (191910-1570)

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Application Number	Filed
09/692,995	10/20/2000

First Named Inventor: Dean F. Jerding

Art Unit	Examiner
2623	BELIVEAU, Scott E.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)
- ☐ attorney or agent of record. Registration number _____
- ☒ attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34: 47,034

Signature

David Rodack
Typed or printed name

770-933-9500
Telephone number

01/08/2007
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Jerding, *et al.*

Serial No.: 09/692,995

Filed: October 20, 2000

Confirmation No.: 8091

Group Art Unit: 2623

Examiner: Beliveau, Scott E.

Docket No. A-6687 (191910-1570)

REMARKS IN SUPPORT OF PRE-APPEAL BRIEF CONFERENCE

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Applicants submit the following remarks in support of a Request for a Pre-Appeal Brief Conference.

REMARKS

Claims 80, 82, 83, 85, 86, 90-92, 96-100 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over *White* ("*White*," U.S. Patent No. 6,628,302 B2) in view of *Lewis et al.* ("*Lewis*," WO 00/04726 A2). Claim 93 stands rejected under 35 U.S.C. §103(a) as allegedly unpatentable over *White* in view of *Lewis* and in further view of *Dunn et al.* ("*Dunn*," U.S. Patent No. 5,861,906). Claims 94, 95 and 101 stand rejected under 35 U.S.C. §103(a) as allegedly unpatentable over *White* in view of *Lewis*, and in further view of *Wang* ("Wang," U.S. Patent No. 6,501,902 B1). For purposes of the pre-appeal brief conference, Applicants respectfully traverse these rejections as applied to claims 80, 82, 83, 85, 86, 90-101, and respectfully submit that there exists clear cases of error, supported by the evidence in the record, in this rejection.

I. Rejection of Independent Claims 80 and 96

Although Applicants believe claims 80 and 96 to be patentably distinct, the clear errors in rejecting similar elements for these two claims are presented in this section to facilitate the review.

In the Continuation Sheet of the Advisory Action dated November 27, 2006, which affirmed the rejection of claims 80, 82, 83, 85, 86, 90-101 rejected in the final Office Action dated September 8, 2006, the Examiner erroneously omits one or more essential elements needed for a prima facie rejection, namely "receiving a second user input configured to request from the headend the visual scene in the video presentation ***after the STT has output at least another portion of the video presentation***" and "responsive to receiving the second user input, ***requesting by the STT that the headend send the video presentation beginning from the requested visual scene***." In other words, claims 80 and 96 require the STT to deliver the video presentation both during and after the bookmarking, and that the visual scene be delivered by the headend based on locally-stored (local to the STT) information pertaining to the visual scene.

On page 4, section 6 of the final Office Action dated September 8, 2006, the Examiner states, in the context of what *White* allegedly teaches, that while "the reference teaches that the system is operable to facilitate and control the particular playback of the on-demand presentation from the "server" [12] in association with various video playback commands, the reference is silent with respect to the particular 'bookmarking' as claimed." The Examiner then cites *Lewis* on page 7 of the final Office

Action as a basis to support the alleged teaching of bookmarking. Applicants respectfully disagree, and as pointed out in Applicants' response dated November 8, 2006 (page 12), *Lewis* fails to teach the emphasized claim features because *Lewis* appears, *arguendo*, to describe the functions of a DVD player, and not a STT and its interaction with a headend in a VOD system as recited in claims 80 and 96.

In the Advisory Action dated November 27, 2006 (Continuation sheet), the Examiner alleges that *White* "clearly include[s] the particular output of multiple portions of a video both prior to and subsequent to the various playback commands." Applicants respectfully submit that *White*, which appears *arguendo* to describe stop and pause functions in the context of interaction between a headend and a client (and not bookmarking functions), does not show the multiple portions of video as claimed since, as explained on pages 11-12 in Applicants' response dated November 8, 2006, once the stop or pause functions of *White* are activated, the system in *White* does not appear to output any portion of content until resumption from the scene from which the interruption was commenced. That is, the system in *White* does not show that a previously bookmarked visual scene can be requested by the STT and delivered by the headend after the headend has delivered content from the same presentation beyond that bookmarked scene since, according to *White*, no content from a given presentation is delivered by the headend after a pause or stop. Thus, not only is bookmarking not the same as stop and pause functions, but the Examiner has omitted these explicit claim elements needed for a prima facie rejection, and thus the rejection is improper.

In addition, Applicants respectfully submit that the combination of *Lewis* and *White* is not obvious, and thus there is clear legal error. As explained on page 13 of Applicants' response dated November 8, 2006, *White* (presented in the context of interactive video programming methods between an entertainment headend over a network to client terminals, as explained in the Abstract) describes no bookmarking and no delivery of content from a given video presentation after a stop or pause function. The Examiner, apparently relying on a single sentence (page 3, starting at line 14) in *Lewis*, states on page 5 of the final Office Action that *Lewis* "discloses a method that is described as being applicable to any digital video apparatus that allows for the digital video apparatus to quickly locate a particular data block and begin playback from a selected location." As stated in Applicants response (page 13) dated November 8, 2006, the combination of *White* and *Lewis* is unreasonable because there is considerable

complexity involved in bookmarking content from the headend of a VOD network that is not addressed or adequately disclosed in the art references.

In the Advisory Action dated November 27, 2006 (Continuation sheet), the Examiner replies to Applicants' arguments from the November 8th response by stating that "irrespective of complexity, the particular knowledge required to perform headend based 'bookmarking' is within the ordinary skill in the art as evidenced by the art of record (ex. Budow et al. (US Pat No. 5,625,864), Goode et al. (US Pat No. 6,166,730), etc.)." Applicants respectfully submit that, even assuming *arguendo Budow* and/or *Goode* can be combined with *Lewis* and *White* (a showing of which has not been made), *Budow* and *Goode* still fail to disclose the above mentioned essential elements of claims 80 and 96. For instance, *Budow* does not teach continual feed of video after an interruption.

In view of the foregoing, *Lewis* and *White* do not disclose, teach, or suggest the elements of claims 80 and 96. Further, Applicants respectfully submit that the additional references, *Wang* and *Dunn* or other art of record, fails to disclose, teach, or suggest at least the essential elements of claims 80 and 96 (and dependent claims 82, 83, 85, 86, 90-95, and 97-101), and the rejection to the same is clearly improper due to errors and/or omissions by the Examiner.

CONCLUSION

Favorable reconsideration and allowance, or the re-opening of prosecution on the merits, of the present application and claims 80, 82, 83, 85, 86, 90-101 are hereby courteously requested.

Respectfully submitted,

THOMAS, KAYDEN, HORSTEMEYER & RISLEY, L.L.P.

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